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| KENYON & KENYON 1500 K STREET, N.W., SUITE 700 WASHINGTON, DC 20005 | | | CHEN, TE Y | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,904

Applicant(s)

MONROE, STEVEN C.

Examiner

Susan Y Chen

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2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 28 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 21-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

This is in response to amendment filed on 10/10/2003 (paper # 6).

Claims 21 - 50 are pending for examination, claims 1-20 are rejected.

The request for revocation of prior powers of attorney is acknowledged and accepted by the Office.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicants may become aware in the specification. Also, It is noted that the present specification does not number each line for the claims. For ease of reference by both Examiner and Applicant all future correspondence should include a recommended line numbering format –that is to number each line of every claim, with each claim beginning with line 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 21-50 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 21, 31 and 41, Applicant fails to disclose the identifying mechanism used by the instant invention to distinguish the claimed first corresponding domain name record and the second corresponding domain name record from a plurality of records in the claimed registrar database. Furthermore, applicant fails to define the structures and links of the claimed first corresponding domain name record and the second corresponding domain name record in the claimed registrar database, since the identifying mechanism, structures and links of these records are not defined, thus, the instant invention does not allow one skilled in the art to which it pertains, or with which it is most nearly connected to compare the first record to the second record or update the second record based on the first record as claimed. In another words, the instant invention does not enable one skilled in the art to which it pertains, or with which it is most nearly connected to make and/or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 21-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 21, 31 and 41, it is not understood what are the claimed first corresponding domain name record and the claimed second corresponding domain name record referred to? How are they organized in the claimed database? What technique was used by the instant invention to identify the records in the database to be the first one or second one?

As to claims 22-30, 32-40 and 42-50, these claims have the same defect as their base claims, hence are rejected for the same reason.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 21-25, 27-35, 37-45 and 47-50, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,519,589 issued to Mann (hereinafter referred as Mann '589).

Claim 21:

Mann '589 discloses:

A whois database [e.g., the InterNIC Whois domain name lookup database, S3-11, Fig. 3C; the snapshot of WhoisPlus, Fig.5A-D], comprising:

- extracting a plurality of unique identifiers from an audit file [e.g., the Root Zone file (112), Fig. 1; the Candidate Domain Name Output Log; col. 4, lines 9-12; col. 5, lines 39-42; col. 6, lines 18-20, Fig. 5D] ; and
for each unique identifier:
- looping though the database to determining whether a first and subsequent candidate domain names having a match with the corresponding domain name record exist within the registrar database [e.g., col. 5, lines 39 – 53], wherein the matching process comprising the determination [e.g., col. 6, lines 5-13], comparing [e.g. col. 6, lines13-117], and updating [e.g., col. 6, lines 18-20] processes of the associated domain name records as claimed by the applicant.

Claim 22:

The cited feature -- deleting a second domain name record if the first corresponding domain name record does not exist -- is a default domain name system processing¹.

¹ The typical domain-name query processing in a whois database system is initiated from the host to a plurality of second level domain server, the whois database includes information identifying technical and administrative contact personnel responsible for a given second level domain server. When a request of searching for target domain name is received by the host, if the first corresponding domain name record

Claim 23:

The cited feature -- adding a first domain name record to the whois database if the second corresponding domain name record does not exist -- is a default domain name system processing² also.

Claim 24:

The cited feature -- discarding duplicate unique identifiers from the plurality of unique identifiers -- is the nature property of unique identifier.

Claim 25:

The cited features -- modified domain name record consists of an added domain name record, a deleted domain name record and changed domain name record -- are inherent for any modification processing performed on a domain name data item.

Claim 27:

Mann '589 further discloses:

of the given second level server is not able to be identified, then there is no need to continue the searching processing, thus, deleting the second (or subsequent) domain name record from the whois database is a must in order to keep the database clean without stale entities.

² Since the whois database includes information identifying technical and administrative contact personnel responsible for a given second level domain server. When a scan request of searching for target domain name is received by the host, if the first corresponding domain name record of the given second server is identified but the second correspond domain name record does not exist, then adding the first corresponding domain name record of the given server is a must in order to continue the searching processing and make the whois database having only one copy of the most up-to-date data for the first domain name record.

The audit file includes modified domain name information [e.g., see the available candidate domain name output (514), Fig. 5D] associated with each unique identifier [e.g. the e-mail identifier (513), Fig. 5D].

Claim 28:

Mann '589 further discloses:

the plurality of unique identifiers are associated with a time period [note: e-mail is default to be automatically associated with system data and time].

Claim 29:

Mann '589 further discloses:

tagging the audit file to identify previously extracted unique identifiers via e-mail [e.g. Fig. 5d].

Claim 30:

Mann '589 further discloses:

The whois database is a copy of registrar database [e.g. see the spawn WHOIS processing at S3-11, Fig. 3C].

claims 31-35, 37-45 and 47-50, these claims recite the same features as claims 21-25 and 27-30 in form of computer system and computer-readable program product, hence are rejected for the same reason.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 26, 36 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann '589 in view of U.S. Patent No. 5,134,696 issued to Brown et al. (hereinafter referred as Brown '696).

Claim 26:

The prior art including Mann '589 discloses all the features claimed by applicant as shown by the above discussion, except the limitation of using an indicator to indicate the type of add, delete and change processing corresponding to a unique identifier of an audit file.

Brown '696 discloses the claimed feature [e.g. see Abstract, col. 10, lines 36-39].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the auditing file in Mann '589 system with an indicator as taught by Brown '696.

The ordinarily skilled artisan would have been motivated to modify Mann '589 per the above for the purpose to facilitate the tracking of various adding, deleting and

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changing operations performed on the domain name which corresponds to an unique identifier in the audit file.

Claims 36 & 46, these claims recite the same feature as claim 26, in form of computer system and computer program product, hence are rejected for the same reason.

Response to Arguments

Applicant's arguments with respect to claims 21-50 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Broadhurst (U.S. Patent No. 6,560,634), which discloses a data processing system with method and means to determine the availability of an internet domain name; Blair et al. (U.S. Patent No. 6,182,227) which discloses a lightweight authentication system and method for validating a server access request.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y Chen whose telephone number is (703) 308-1155. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (703) 308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-6296.

Susan Chen
Dec. 19, 2003


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